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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,361	01/11/2002	Vance Martin Patterson	A7183	5710

7590 02/26/2004

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EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 02/26/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/042,361

Applicant(s)  
Patterson et al.

Examiner  
Ljiljana V. Ciric

Art Unit  
3753



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 19, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 11, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group I, readable on claims 1 through 19 and 27 through 30, in Paper No. 6 is acknowledged.
2. Claims 20 through 26 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

### ***Specification***

3. The abstract of the disclosure is objected to because the last sentence thereof refers to the purported merits of the inventive apparatus. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: the first paragraph on page 3 of the specification recites plural "means" clauses (i.e., language normally reserved for claims) without providing any definitions or examples of equivalents therefor.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1 through 19 and 27 through 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They contain both grammatical and idiomatic errors.

With regard to claim 1 as written, it is not clear what is encompassed by "an input" as recited in line 2 of the claim nor what is encompassed by "a base unit output" as recited in claim 3 of the claim. Because it is not clear whether these terms refer to signals or to airflows or to something other altogether, the metes and bounds sought by claim 1 and all claims depending therefrom are indefinite. Each of claims 19 and 27 contain the same limitations and is similarly rendered indefinite thereby.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "sump" appearing in each of claims 4 and 28 is used by the claim to mean "a pump," while the accepted meaning is "a tank or reservoir for overflow."

Claim 4 recites "at least one evaporative cooling medium, positioned within a frame of said single base unit". While an evaporative cooling medium is recited, the context of the claim appears to warrant the recitation of an evaporative cooling element or apparatus and not a medium per se. Thus, the intended scope of protection sought is not clear, and the claim is further

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rendered indefinite thereby. Claim 28 contains the same limitations and is similarly rendered indefinite thereby.

With regard to claim 7 as written, it is not clear whether or not the blower is or is not being positively recited by the claim or whether it is merely referred to in order to indicate the intended use for the differential pressure control. It also appears that the various sensors being monitored are not positively recited. Finally, it is not clear whether the limitations "an over-temperature pressure sensor" as recited in the claim refers to an over-temperature and over-pressure sensor or whether there is a word or words missing from the limitations as written, thus further rendering the claim indefinite as written.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481

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(Bd. App. 1949). In the present instance, claim 9 recites the broad recitation of the prescribed range of the heated output range being 75,000 BTU/hour", and the claim also recites the heated output being 200,000 BTU/hour which is the narrower statement of the range/limitation.

Also with regard to claim 9 as written, it is not clear to what the limitation "said heated output range" refers, especially since there is no antecedent basis for this limitation in the claims.

There is insufficient antecedent basis in claim 13 for reciting "an igniter and at least one control circuit in said first attachment unit".

Claim 14, for example, appears to recite method steps in an apparatus claim, thereby rendering the scope of protection sought indefinite.

Claim 19 recites plural nested means-plus-function recitations, including one comprising the preamble, yet applicant has failed to clearly specify to which equivalents each of these means corresponds. Also with regard to claim 19, there is insufficient antecedent basis for the recitation of "said single base unit".

Also for example, the recitation of "a double pulley device attached to said blower" in claim 16 follows a wherein clause and is not previously positively recited in the claim. It is thus not clear whether or not the aforementioned represents a positive recitation of the double pulley device as being attached to the blower.

With regard to claim 27 as written, it appears that a word or words are missing from the limitations " and one of generate one of a heated output and output a cooled output generated in the single base unit", thus rendering the scope of protection sought by claim 27 and all claims

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depending therefrom indeterminate.

Finally, for example, the limitations “a power supply is *switchably provided*” appearing in claim 30 are not clearly understood as written. What exactly does being “switchably provided” encompass?

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. As best can be understood in view of the indefiniteness of the claims, claims 1 through 8, 10, 12, 13, 17, 18, 27, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by *Talbert et al.*

*Talbert et al.* discloses an apparatus for adjusting air temperature essentially as claimed, including, for example: three units 100, 200, and 210 as shown in Figure 12; a blower 266 or 88; a fuel source and burner 40; a reservoir 20; a sump (i.e., pump) “that pumps” 66; and, an ignition

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module as shown in Figure 15, including a flame sensor or flame sensor module 304 connected to an igniter unit 300.

The reference thus reads on the claims.

9. Alternately for claims 1 and 27, and as best can be understood in view of the indefiniteness of the claims, claims 1, 11, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by *Tippmann et al.*

*Tippmann et al.* discloses an apparatus for adjusting air temperature essentially as claimed, including plural units or modules and wheels 24 allowing movement of the apparatus.

The reference thus reads on the claims.

#### ***Allowable Subject Matter***

10. Claims 14 through 16 and 28 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The non-application of art against claims 9 and 19 should not be construed as an indication that the claims contain allowable subject matter but rather that the patentability of the claims cannot be determined at this time due to indefiniteness and/or other problems under 35 U.S.C. 112, first and second paragraphs.

#### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

January 23, 2004

  
LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753